



UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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KURT G. BRISCOE, ESQ.
NORRIS, MCLAUGHLIN & MARCUS, P.A.
660 WHITE PLAINS ROAD
TARRYTOWN, NEW YORK 10591-5514

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In re Application of
Heinrich Gers-Barlag et al
Serial No.: 09/265,779
Filed: March 10, 1999
Attorney Docket No.: Beiersdorf 416.2-KGB

WITHDRAWAL OF ABANDONMENT

This is in response to applicants' petition under 37 CFR 1.181, filed March 26, 2001, requesting revival of the above-identified application based on timely filing of a response to an Office action.

A review of the file history shows the examiner mailed an Office action to applicants on June 22, 1999, setting a three month shortened statutory period for reply. Upon failure to receive a reply the application was held abandoned by Notice of Abandonment mailed March 16, 2000.

Applicants state that Continued Prosecution Application (CPA) papers were filed on December 22, 1999, including a Petition for a Three Month Extension of Time and fees therefor. However, all papers filed referred to prior application number 08/788,147, which is the parent of 09/265,779, the instant application. After applicants received the Notice of Abandonment, applicants resubmitted the CPA and Petition for a Three Month Extension of Time via fax on March 21, 2000 (apparently without correcting the Serial No.). However, while the fax cover sheet referred to application number 09/265,779, the originally submitted CPA and Petition for a Three Month Extension of Time referred to parent application 08/788,147. Subsequent written status inquiries were not answered by the Office. Applicants state on March 1, 2001, Ms. Rosa Thomas indicated by telephone that the application was still regarded as abandoned, and that a petition seeking to withdraw the holding of abandonment should be filed.

Applicants include as evidence of timely reply a copy of the fax confirmation, fax cover sheet, CPA Request Transmittal, Petition for Extension of Time, Notice of Change of Firm Name, Express Mail Label, and status letter dated August 29, 2000. All of these papers include as the application Serial No. 08/788,147. Applicants also include a copy of the Express Mail Certificate dated December 22, 1999, and an unexecuted copy of the Express Mail Label.

Applicants quote M.P.E.P. 201.06(d), as follows:

A request for a CPA must identify the prior nonprovisional application (37 CFR 1.53(d)(2)(I)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the patent examining group should attempt to identify the proper application number by reference to other identifying information


provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney's docket number of the prior application. If the patent examining group is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. If the patent examining group is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number.

Obviously applicants did not identify the correct application number for which the CPA papers were filed, as required. The identifying indicia contained in the papers refer to a parent application and contain the correct Serial No. and filing date thereof and which has the same inventorship, title, and strikingly similar docket number (differing only in the last digits). It is noted that the attorney docket number for the CPA papers does not match in all respects the attorney docket number of Serial No. 09/265,779. Thus, despite reasonable efforts the originally filed papers could not be identified as belonging to Serial No. 09/265,779. The filed papers were likely correlated with the application to which they were directed, namely Serial No. 08/788,147. However, upon correlation such papers would have been considered improper as Serial No. 08/788,147 issued as a patent on October 19, 1999, two months before the papers were filed. Since all of the identifying indicia on the CPA papers was consistent with the application to which they were mistakenly directed, the Office had no reason to make any further effort to identify another application to which the papers could have been directed. Had the identifying indicia not been consistent with the mistakenly identified application (applicants' names were different, different docket number, etc.) the Office would have expended some effort to identify the correct application to which the papers should have been directed. The Office cannot be held responsible for fixing applicants' errors. The Office does make an effort to determine correct Serial No.'s where there is a clear error (e.g. transposed digits) in the Serial No. Such is not the fact situation here..

It is noted that this application only contains CPA papers which still have the wrong parent application Serial No. Applicants have made no effort to correct the error in the filed papers.

Applicants' petition is **DENIED**.

Any request for reconsideration of this decision must be in the form of a renewed petition under 37 CFR 1.181 or, alternatively, under 37 CFR 1.137 and must be filed within TWO MONTHS of the mailing date of this decision. Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.


Jasmine C. Chambers
Director, Technology Center 1600